REMARKS

Claims 55-63 are currently pending in the application and claims 1-54 have been cancelled. In paper 35, the Examiner allowed claims 50 and 53-59. Applicants then added claims 60-62 in an amendment and response, filed on August 8, 2002. The Examiner reconsidered the allowance and the rejected claims 50 and 53-39 after allowance, while also rejecting new claims 60-62, in paper 42 under 112(1) as not enabled. Specifically, the action reads that the claims are not enabled for " a method for screening candidate compounds capable of inhibiting HMGI biological activity where the biological activity is not defined, comprising the steps of (a)-(c) and determining whether the compound modulates HMGI biological activity from its ability to bind to the HMGI protein or the functional fragment, or, comprising the steps of (d)-(g) by administering a compound to a cell."

In a April 2, 2003 teleconference, the Examiner indicated that if the claims were amended to further explain the HMGI "biological activity" and if all independent claims included the step of first screening candidate compounds on an immobilized surface, the claims would likely be allowable.

Without prejudice to further prosecution, Applicants have made the required amendments to secure allowance of this case. Specifically, applicants have added an explanation of relevant biological activity to all pending independent claims and support for this amendment can be found throughout the specification.

In particular, the term "biological activity" is referred to throughout the specification as the functionality of HMGI is explained. On page 3, lines 17-21, it states: "The HMGI proteins have no transcriptional activity per se, but through protein-protein and protein-DNA interactions organize the framework of the nucleoprotein-DNA transcriptional complex. This framework is attained by their ability to change the conformation of DNA and these proteins are therefore termed architectural

factors." "Biological activity" is explicitly defined in the specification at page 32, lines 4-9. Finally, Applicants direct attention to page 53, lines 20-25, which states: "As an architectural component of the enhanceosome, a higher order transcription enhancer complex that forms when several distinct transcription factors assemble on DNA in a stereospecific manner, HMGI proteins function to regulate the expression of downstream target genes. Disruption of the enhanceosome assembly, by interfering with protein-DNA or protein-protein interactions of HMGI proteins results in a loss of transcriptional regulation."

Also without prejudice to further prosecution, Applicants have added the limitation of screening candidate compounds capable of inhibiting HMGI biological activity to every independent claim. Applicants amended claims 58 and 59 to add the quantifying reduction in HMGI biological activity as a dependent claim limitation to all independent claims. Thus, Applicants respectfully assert that the rejections of the most recent nonfinal office action are obviated.

CONCLUSION

In view of the foregoing, it is submitted that the claims are allowable, and issuance of a Notice of Allowance is requested. The Commissioner is authorized to charge any fees required by the filing of these papers, and to credit any overpayment to Perkins Coie's Deposit Account No. **50-0665**. If Applicants can do anything more to expedite this application, Applicants ask the Examiner to contact the undersigned at (310) 788-9900.

Respectfully submitted,

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